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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/657,394	09/08/2003	William J. Mertz	1248 P 122	9357

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MCDERMOTT, WILL & EMERY LLP
227 WEST MONROE STREET
CHICAGO, IL 60606-5096

EXAMINER

MOORE, MARGARET G

ART UNIT

PAPER NUMBER

1796

MAIL DATE

DELIVERY MODE

02/02/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/657,394

Applicant(s)

MERTZ ET AL.

Examiner

Margaret G. Moore

Art Unit

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 December 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 to 3, 5 to 16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 to 3, 5 to 16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/15/08 has been entered.

2. The Examiner notes that claim 1 has been significantly narrowed from previous claim 1 in that it now requires no more than 10 ppm total volatile compounds, rather than 10 ppm total volatile silicone compounds. Support for this new limitation can be found on page 10, line 4 of the specification.

As an aside the Examiner notes that this language was already present in claim 14. While the "status indicators" in the claims filed 12/15/08 indicate that claim 14 is an originally filed claim, it was in fact added 2/19/07. Future copies of the claims should reflect all claim status correctly.

The Examiner also notes that claim 15 remains limited to 10 ppm volatile silicone compounds.

3. The Examiner appreciates applicants' more detailed Declaration under 37 CFR 1.132. In view of this, the Examiner has withdrawn the rejection over Leir et al. With regard to the rejections over Eckberg et al., please note below.

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Claims 1 to 3 and 5 to 16 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Eckberg et al. '480.

The basis for this rejection is noted in previous office actions and as such this will not be repeated. While the Examiner appreciates applicants' attempts to recreate the

composition in Eckberg et al. and the results provided in the Declaration, this is not sufficient to overcome this rejection for various reasons.

The Examiner's biggest concern regarding the recreation of the prior art composition lies in the fact that '480 specifically teaches a stripping step (top of column 8) that applicants do not appear to have done in their comparative example. Obviously this is a major difference between that in the prior art and that in the recreated comparative example since this step will lower the volatile organics and silicone content. As such this comparative example simply cannot be relied upon as being representative of the prior art. It is unclear if any such step was performed on the GE UV-9400 silicone prior to formulation.

In view of this the Examiner maintains the inherency position from the previous office actions. In the alternative, though, the teachings of Eckberg et al. render obvious the claims.

Column 6, lines 19 - 21, teach that the reaction mixture is devolatilized to remove excess low molecular weight siloxanes. This indicates that volatile siloxanes and such are not desired in the final product. Since one having ordinary skill in the art would have been motivated by the teachings in Eckberg et al. to remove as much of the volatile siloxanes as possible, this would render obvious a final product having the low residual siloxane content as claimed. It has been held that where the general conditions of a claim are disclosed in the prior art discovering the optimum or workable ranges involves only routine skill in the art (i.e. does not require undue experimentation).

On the other hand, *if* applicants were to establish that the recreated example in the Declaration is, in fact, an accurate example of the composition in Eckberg et al., the Examiner notes that this example shows an extractable siloxane content of 1.91. Claims 12 and 15 have an upper limit of *about* 1.5. It is unclear if there is a difference between "about 1.5" and "1.91" since the term "about" allows for a degree of latitude and breadth that includes values that are greater than 1.5. Even if "about 1.5" is not considered broad enough to embrace "1.91", a prima facie case of obviousness exists where the claimed ranges and prior art ranges do not overlap but are close enough that one skilled in the art would have expected them to have the same properties. Since both the claim-

ed composition and that in the prior art have the same utility, one can expect them to have the same properties. Again, then, a case of obviousness is made for these claims over the teachings in Eckberg et al. '480.

In view of that noted above, this rejection is maintained.

6. Claims 1 to 3 and 5 to 16 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Eckberg et al. '453.

The basis for this rejection is noted in previous office actions and as such this will not be repeated. While the Examiner appreciates applicants' attempts to recreate the composition in Eckberg et al. and the results provided in the Declaration, this is not sufficient to overcome this rejection for various reasons.

Similar to that noted supra, the Examiner notes that Polymer C in '453 is specifically referred to as "devolatilized". Obviously this is a major difference between that in the prior art and that in the recreated comparative example since this step will lower the volatile organics and silicone content. Thus this recreated example cannot be relied upon as being representative of the prior art. In addition, Polymer C is not the only silicone polymer in '453 that would appear to result in a release coating as claimed. For instance note that Polymer D is a radiation curable silicone and the preparation thereof specifically refers to the removal of solvents and other light ends (column 11, lines 12 and 13). Only showing one embodiment (silicone polymer) from the prior art that is within the breadth of the claims does not serve to adequately distinguish all prior art embodiments from that claimed.

Other concerns the Examiner has with the data provided in this Declaration include the fact that '453 shows many different examples using Polymer C, some of which use 100% Polymer C, while applicants have only shown two examples. In fact the Examiner it is not clear to the Examiner if these are even comparable examples to the closest prior art in Eckberg et al. In addition, applicants use a silicone having a viscosity of 225 cstK in place of a silicone having a viscosity of 300. This is a concern because it is unclear how this 25% reduction in viscosity of the coating siloxane affects the removal or even the initial presence of low viscosity silicones.

On the other hand, assuming one can consider the recreated examples to be an accurate depiction of the prior art, the Examiner notes that the extractable siloxane and outgassing siloxane data shown in the Declaration meet the requirements of claims 12 and 15.

In addition, the Examiner relies on the grounds of obviousness as noted supra. That is, since Eckberg et al. '453 relies on the teachings of '480 and both teach and/or suggest the removal of volatiles, one having ordinary skill in the art would have found the removal of as many volatile organics and/or silicones as possible to have been obvious.

In view of these various reasons, this rejection is maintained.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret G. Moore whose telephone number is 571-272-1090. The examiner can normally be reached on Monday and Wednesday to Friday, 10am to 4pm.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Margaret G. Moore/
Primary Examiner, Art Unit 1796

mgm
1/28/09